

REMARKS

Summary of the Office Action

In the Office Action, claims 1-2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,649,661 to *Masuno et al.* ("*Masuno*").

Claims 1-2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,708,821 to *Tucker et al.* ("*Tucker*").

Claims 1-2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,820,789 to *Lipsky et al.* ("*Lipsky*").

Summary of the Response to the Office Action

Applicants amend claim 1 to better clarify the inventions. Claims 3-12 are withdrawn. Accordingly, claims 1 and 2 are presently pending.

Information Disclosure Statement

Applicants submitted Information Disclosure Statements on August 4, 2006, February 8, 2008, April 16, 2008, and December 3, 2008. Applicants thank the Examiner for acknowledging the Information Disclosure Statements by initialing the PTO 1449 form and returning a copy to Applicants.

The Rejections Under 35 U.S.C. § 102

Claims 1-2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Masuno*. Claims 1-2 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Tucker*. Claims 1-2 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Lipsky*. Applicants respectfully traverse the rejections for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Masuno* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102 should be withdrawn. Newly amended independent claim 1 recites, in part, "[a] part clamp to be affixed and nailed to a surface by a nailing machine." After the part clamp is affixed and nailed, it may be used to seat and secure piping along a wall or other structural elements as described in the specification. The part clamp is mentioned in the preamble of claim 1, however, "[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See M.P.E.P. § 2011.02. Applicants respectfully submit that the preamble is necessary to give life, meaning, and vitality to claim 1. Therefore, Applicants respectfully submit that *Masuno*, *Tucker*, and *Lipsky* do not disclose, teach, or suggest a "part clamp" that is affixed and nailed to a surface (*e.g.*, wall or floor joist) by the operation of a nailing gun. *Masuno*, *Tucker*, and *Lipsky* fail to teach or suggest at least these features of claim 1.

Masuno discloses a contact foot (11) to fit inside a holding piece (12) of a nailing gun (4). *Masuno* does not disclose that the contact foot (11) may be nailed to a surface. On the contrary, the contact foot (11) operates to contact the surface that the nail will penetrate. See Fig. 2 and col. 3, lines 35-42 of *Masuno*. *Tucker* discloses a work contact element (30) that ensures pieces (24) of sleeve (22) are not exhausted from tool (10) until the work contact element (30) is lifted off the surface (6) of substrate (2). Therefore, *Tucker's* work contact element (30) also operates

to contact the surface that the nail will penetrate, but does not affix and nail a “part clamp” to a surface. See Fig. 17 and col. 3, lines 54-57 of *Tucker*. Finally, *Lipsky* discloses a washer holder (6) that is releasably secured to the attachment region (2) of a nailing device. The washer holder (6) holds a washer in place by a magnetic retaining means (16) so that a fastener (e.g., nail) may be driven through the hole in the washer, thereby, pinning the washer to a surface. Therefore, the washer holder (6) also operates to contact the surface that the nail will penetrate, but does not affix and nail a “part clamp” to a surface. Only the nail and washer are secured to the surface. See Figs. 2, 3, and 4 and col. 2, line 60 through col. 4, line 34 of *Lipsky*. Accordingly, *Masuno*, *Tucker*, and *Lipsky* fail to disclose, teach or suggest each and every feature of claim 1. Thus, the rejection of claim 1 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102 should be withdrawn because *Kohyama* does not teach or suggest each feature of newly amended independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2 is also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: /David E. Connor/
David E. Connor
Reg. No. 59,868

Dated: March 4, 2011

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, NW
Washington, D.C. 20004
Tel.: (202) 739-3000
Fax: (202) 739-3001